

## REMARKS

Claims 29-33 and 39-59 stand in the application. Claims 1-28 and 34-38 are cancelled. Claims 29, 31, 50, and 59 are in independent form. No new claims are added.

The examiner has rejected claims 56 and 59 under 35 USC 101 as directed to non-statutory subject matter such as a “signal”. The examiner suggested amending claim 59 to include the disclosed tangible computer readable medium, while excluding the intangible media such as signal. Applicant would like to thank the examiner for making the suggestion. Applicant has amendment claim 59 in this response to recited, “A non-transitory computer readable medium” as suggested by the examiner. Claim 56 is dependent on claim 59. Accordingly, applicant requests that the rejection under 35 USC 101 be withdrawn.

Applicant notes that the computer readable medium in claim 59 comprises all computer readable media, with the sole exception being a transitory, propagating signal and waves.

The examiner further rejected claims 29-33, 39-42 and 44-59 under 35 USC 103(a) as being unpatentable over Anderson et al, US 20020087622 (hereafter as Anderson) in combination with Tari et al, US 6,542,491 (hereafter as Tari).

In this reply, applicant amends at least each independent claim 29, 31, 50, and 59 to emphasize the many distinctions over the cited references, either alone or in combination.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If any point of argument or ground of rejection is not specifically discussed by applicant below or previously it should not be construed as agreeing with or acquiescing in the examiner’s reasoning. But rather, applicant submits that any one of the points that is discussed below for example is a sufficient response to the rejection in the Office action.

Reconsideration is requested. In addition to the above amendments, applicant makes the following remarks regarding individual issues:

### CLAIM REJECTIONS

For at least the following reasons, applicant traverses the examiner's §103 rejections. More specifically, applicant has articulated this response as an element-by-element discussion that applicant asserts the claims are patentable over the cited prior art.

#### **1. Anderson is not available as prior art (whether under USC 102 or 103)**

As a preliminary matter, applicant submits that Anderson is NOT available as prior art against the present application. The earliest effective filing date for Anderson is December 29, 2000.

The present application is a continuation-in-part of U.S. Patent Application No. 09/992,413 filed November 18, 2001, which claims the benefit of U.S. Provisional Application No. 60/252,682 filed November 20, 2000. Accordingly, Anderson was filed after the U.S. Provisional Application No. 60/252,682.

Applicant believes that each claim element that the examiner asserts as having been disclosed by Anderson can be found in Provisional Application No. 60/252,682. A listing of the support for the elements cited by the examiner in Anderson is shown in the Priority Table below.

Because Anderson is not available as prior art for the elements cited, applicant respectfully requests that the examiner withdraw the §103 rejection of any element in a claim for which he relies on Anderson, either alone or in combination with any other reference, including Tari.

#### **1.2 SUPPORT FOR CLAIMS FROM PROVISIONAL APPLICATION 60/252,682**

Applicant asserts that each claim element that the examiner asserts as having been disclosed by Anderson is supported by the Provisional Application No. 60/252,682. The Priority Table included below maps each of those claims elements to Provisional Application No. 60/252,682.

<b>Priority Table</b>	
<b>Claim Elements</b>	<b>Examples of Support in 60/252,682</b>
Information apparatus	(Page 1, line 10-17), Fig 1 (100)
Mobile wireless information apparatus	(Page 1, line 10-17), (Page 2, line 21-23), Fig 1 (100)
Touch sensitive screen at the Information apparatus	(Page 4, line 27), (Page 9, line 5)
Digital Content	(Page 1, line 7 ), (Page 9, line 8)
local wireless communication or a wireless local area network	(Page 10, line 18-23), (Page 24, line 10-14), (Page 31, line 12-14 ), (Page 37, line 17-19), (Page 5, line 17-21)
Wireless communication unit	(Page 11, line 8-19), (Page 16, line 23), (Page 27, line 18), Fig 2A, 2B
Short range wireless communication	(Page 24, line 23), Fig 2A, 2B
IEEE802 and Bluetooth™	(Page 30, line 13), (Page 11, line 15), (Page 11, line 30), (Page 24, line 12)
Operating system	(Page 7, line 7), (Page 27, line 26)
Object and or component model	(Page 7, line 7), (Page 27, line 26)
Output device	(Page 1, line 17-24), Fig 1 (106), Fig 3 (3A, 3B, 3C)
Television	(Page 11, line 27), (Page 29, line 24)
Output controller	(Page 25, line 35-33), Fig 1 (106), Fig 3 (3A, 3B, 3C)
Wireless output device	Fig 3 (3A, 3B, 3C)
Searching over wireless	(Page 27, 29-33), (Page 28, 1-2), Fig 5
Discovering over wireless	(Page 27, 29-33), (Page 28, 1-2), Fig 4 (402, 404), Fig 5
Receiving an information from discovered wireless output devices	(Page 35, line 3-8), Fig 5
selecting, at the wireless information apparatus, a wireless output device	(Page 27, 29-33), (Page 28, 1-2), Fig 4 (402, 404), Fig 5
Conforming/generating output data	(Page 43, line 12-14), (Page 24, line 1), (Page 16, line 5), Fig 8 (804)
Compression	(Page 43, line 12-14), (Page 24, line 1), Fig 8 (804)
Encryption	(Page 43, line 12-14), (Page 24, line 8), Fig 8 (804),
Authentication	(Page 34, line 29-32), (Page 35, line 10-25)
In dependence of a successful authentication	(Page 34, line 29-32), (Page 35, line 10-25)
Billing/payment	(Page 35, line 27-33)
Broadcast availability	(Page 31, line 6-14)

## **2. Tari**

Tari teaches wireless communication from a user terminal to the Internet as follows:

*“A ...method for communicating between a user terminal and Internet a wirelessly. It is based on a user terminal having a fixed terminal and a terminal unit so that an Internet connection can be made by way of the terminal unit to an appropriate wireless server. The system has at least one wireless server connected to Internet; and a plurality of wireless station devices connected to the wireless server, and the system communicates wirelessly with the terminal unit of the user terminal”  
(Tari, Abstract)*

Tari does not teach or describe “the transferring of the output data over the short range wireless connection not including transferring the output data over the Internet or via the Internet”. Instead, Tari emphasizes that the connection must be connected to the Internet for transfer of any data.

Following Tari, one of ordinary skill in the art will specifically be instructed to implement a wireless connection that connects to the Internet and NOT over a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

For this reason alone, Tari is not an applicable reference whether alone or in combination with anything including Anderson for describing a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

## **3. Anderson**

Anderson teaches an online website for providing photo services. User device 12 accesses the Internet via a service provider 16 to access the online site (see abstract and summary of invention and Fig 1)

Anderson does not teach or describe “the transferring of the output data over the short range wireless connection not including transferring the output data over the Internet or via the Internet”. Instead, Anderson emphasizes that the connection must be connected to the Internet for uploading and downloading data to the online photo service site.

Following Anderson, one of ordinary skill in the art will specifically be instructed to connect to the Internet and NOT over a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

For this reason alone, Anderson is not an applicable reference whether alone or in combination with anything including Tari for describing a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

**4. Short range wireless connection being compatible with one within IEEE802.11 wireless standard or being one compatible with Bluetooth™ standard**

The examiner agrees that neither Anderson nor Tari teach or describe IEEE802.11 or Bluetooth as recited in each independent claim. However, because of the explicit teaching by both Anderson and Tari to communicate by connecting to the Internet, Anderson or Tari cannot be combined with any other reference including Evan (US 6,690,918 B) under §103 to teach one of ordinary skill a short range wireless communication that removes or excludes the Internet from Anderson or Tari while keeping the remaining disclosure unchanged or unaffected.

Anderson and Tari explicitly teach communication using the Internet. Neither Anderson nor Tari suggest anything related to removing the Internet for communication. Accordingly, one of ordinary skill will not be led or motivated to modify Anderson or Tari to remove the Internet. Furthermore, a combination of Tari and Anderson with anything to remove the Internet communication from the system of Anderson or Tari as suggested by the examiner will produce unexpected results or a result that will predictably make the system of Anderson or Tari inoperable (without the explicit Internet being included).

**5. Output device associated with a television**

Anderson does not describe an output device. Instead Anderson describes an online service site. The examiner alleges that online site is an output device. It is well known by one of ordinary skill in the art that an online site is not an output device. Moreover, it is well known by one of ordinary skill in the art that an online site is not “an output device associated with a television”. An online site storing content (regardless of the type of content) does not inherently or explicitly make the online site a television. For example the

Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be **made explicit** (emphasis added, see also *KSR Intl Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007)). In the absence of an explicit definition or teaching by Anderson or Tari that an online site is “an output device associated with a television”, it would be improper to allege that Anderson or Tari discloses that “an online site” is the same as an “output device associated with a television.”

If the examiner is asserting “an online site” is inherently an “output device associated with a television”, applicant respectfully requests support for the inherency assertion in accordance with MPEP § 2112(IV)). Applicant notes that “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” MPEP § 2112(IV), quoting *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed.Cir. 1999).

## **6. Search**

The examiner relies on Tari as disclosing the step of searching wirelessly for a wireless device that is available for wireless communication. The fact that Tari discloses that wireless communication is established does not constitute disclosure of the step of searching for a wireless device that is available for wireless communication. If the examiner considers that the step of searching wirelessly is disclosed expressly by Tari, applicant requests that the examiner explain more closely the supporting interpretation of the passage at column 1, lines 40-51. If the examiner considers that the step of searching wirelessly is inherent in the disclosure of Tari, applicant requests that the examiner explain specifically the operation of Tari that constitutes searching.

## **7. Selection**

The examiner asserts that Tari discloses the step of selecting a wireless output device discovered in the search. In support of this assertion, the examiner points out that “the host server 1 knows that the terminal unit 5-1 is in the managing district ... because of the source address of the packet at Step S24.” Applicant submits that this operation of Tari does not constitute selecting a wireless output device, as set forth in claim 29. If the

examiner considers that the step of selecting is disclosed expressly by Tari, applicant requests that the examiner explain more closely the supporting interpretation of the passage at column 5, lines 7-13. If the examiner considers that the step of selecting is inherent in the disclosure of Tari, applicant requests that the examiner explain specifically the operation of Tari that constitutes selecting.

## **8. Authentication**

Claim 31 recites authentication as follows:

“obtaining at the mobile wireless information apparatus a security key from the user for accessing the selected wireless output device;

sending at the mobile wireless information apparatus the security key over the wireless communication channel for authenticating access of the mobile wireless information apparatus to the select wireless output device;

receiving over the wireless communication channel at least an indication related to a successful security key authentication, and in dependence of a successful security key authentication,

establishing a restricted wireless connection between the mobile wireless information apparatus and the selected wireless output device”

The examiner appears to rely on Tari column 4, lines 4-14 as disclosing the authentication steps of claim 31. The pertinent part of the cited passage of Tari reads:

*“The terminal unit 5-1 requests from wireless server B3-2 a terminal registration approval and an IP address (refer to (a) in FIG. 2, step S1 in FIG. 3). In response, wireless server B3-2 issues registration approval and an IP address (refer to (a), and step S2 in FIG. 3), thus enabling the terminal unit 5-1 to operate under the wireless server B3-2.” (Tari, Col 4, line 7-14)*

As shown, Tari does not describe authentication, nor does it describe each and every step associated with authentication recited in claim 31. For example, Tari does not describe or teach a security key. Applicant submits that it is well known by one of ordinary skill in the art that “a registration approval” is not a security key.

In the present case, applicant respectfully requests further clarification from the examiner of whether “a registration approval” as mentioned by Tari is considered to be, expressly or inherently, a security key. If the examiner considers “a registration approval” to be express disclosure of a security key, applicant respectfully requests that the examiner should explain where Tari expressly states that “a registration approval” is a security key. If the examiner considers that “a registration approval” is inherently a security key, applicant respectfully requests support in accordance with MPEP § 2112(IV).

### **9. Encryption**

Claims 31 and 59 have further been amended to recite:

“the conforming of the digital content into an output data includes an encryption operation”

Applicant notes that neither Anderson or Tari teach or describe “the conforming of the digital content into an output data includes an encryption operation” whether alone or in combination.

### **10. Touch sensitive display**

Claim 31 recites:

“the interface including at least a touch sensitive screen, the method comprising:  
receiving over the...interface...at least an indication related to a selected...content for output”

The examiner does not appear to have addressed this element of claim 31 in the Office action. Applicant submits that neither Anderson nor Tari teaches or describes

“the interface including at least a touch sensitive screen, the method comprising:  
receiving over the...interface...at least an indication related to a selected...content for output”

whether alone or in combination. If the examiner considers that Anderson or Tari discloses or suggests this step of claim 31, applicant respectfully requests that the



examiner provide support and clarification so that applicant may properly traverse a rejection in a future Office action.

#### CONCLUSION

Applicant respectfully requests reconsideration and allowance of all pending claims of the application as amended. Applicant reiterates that Anderson is not available as prior art. And for at least the foregoing distinctions 1 through 9 outlined above, applicant believes the application is in condition for allowance and respectfully requests the same. The examiner is encouraged to telephone the undersigned at (503) 278-3334 or the applicant William Chang at (503)-381-7056 if it appears that an additional interview would be helpful in advancing the case.

Respectfully submitted,

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